

REMARKS

Applicant acknowledges the Examiner's careful review of this application.

Applicant does, however, respectfully request reconsideration and allowance.

Renewed Request to confirm Information Disclosure Statement.

Applicant respectfully directs the Examiner's attention to the Information Disclosure Statement filed May 12, 2003, postcard receipt attached. Applicant requests the Examiner to acknowledge consideration of the disclosed information.

Support for the Claim Amendment

The Amendment does not raises a new issue, does not present new matter and does not increase the total number of claims. Applicant therefore earnestly but respectfully, requests the Examiner to enter this Amendment.

Amended claim 1 recites the insoluble methyl-methacrylate particles have a uniform composition, i.e., are not core-shell structured - that is they can be said to be single layered. Applicant refers to the insoluble methyl-methacrylate particles as having uniform composition, which means that the particles have no core-shell structure, as the term "particles having single-layer structure." The particles inherently have single-layer structure, as taught by, for example, the processes for producing the insoluble methyl methacrylate particles disclosed in page 9, lines 8-12, and from page 16, line 25 to page 17, of Applicants' specification. These processes automatically result in providing the particles having single-layer structure.

Claims Rejections - 35 U.S.C. §112

Claims 1, 2, 5, 8-12 and 15-23 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. This rejection is based on the Examiner's position that the original disclosure contains neither

explicit nor implicit support for the limitation "where the resin layer (A) has no insoluble methyl methacrylate particles."

Applicant traverses this rejection.

The claim language in question finds actual support in the originally filed specification. *See, e.g., In re Edwards*, 586 F.2d 1349, 1351-52 (CCPA 1978) ("it is not necessary that the application describe the claimed invention in *ipsis verbis*; all that is required is that it reasonably convey to persons skilled in the art.... the inventor had possession of the subject matter later claimed by him."). The PTO has the burden of demonstrating the factual support for a rejection under Section 112(1). *Id.* at 1356. Attention is respectfully directed to the Examples disclosed in the original specification. The resin layers (A) in Examples 1-6 used for obtaining the laminated extruded resin sheets therein have no insoluble methyl methacrylate particles. This means that the resin layer (A) having no insoluble methyl methacrylate particles is disclosed in the original disclosure, and therefore, claims 1, 2, 5, 8-12 and 12-23 comply with the written description requirement.

Prior Art Rejections

Applicant traverses all the rejections, including the rejection under 35 U.S.C. §103(a) of the claims listed over JP-55-034924 A (hereinafter, referred to as Toyooka) in view of WO 97/30117 (Tadokoro et al.) and Koizumi et al. (USP 6,309,739) or Toritani et al. (USP 5,169,903) (see, page 3, item 1 in the outstanding Office Action).

Applicant traverses the rejections for reasons detailed below, but presents these salient points to emphasize there is no *prima facie* case.

(1) the insoluble methyl methacrylate particles having single-layer structure and having a weight-average particle size of 1.0 to 33 μm are not disclosed in the cited references;

(2) Tadokoro teaches away for the usage of the currently amended claim in view of the particles having single-layered structure; and

(3) the advantages of the claimed invention, for example, to provide a molded article having bias of thickness in secondary thermoforming (see, page 13, lines 17-20 of Applicants' specification), would have been unexpected over the cited references.

According to the last Office Action, the Examiner apparently has opined that "it would have been obvious to one of ordinary skill in the art to utilize the decorative sheet taught by Tadokoro as the polyalkyl methacrylate printed film of the laminate taught in Toyooka because it maintains surface hardness, and is produced simply and inexpensively." It appears from the current Office Action at page 3, third line from the bottom to page 4, line 1 that the Examiner adheres to this opinion and relies upon it as basis for the rejection over Toyooka in view of Tadokoro et al.

Applicant respectfully submits that such a utilization of the decorative sheet taught by Tadokoro as the polyalkyl methacrylate printed film of the laminate taught in Toyooka is rooted in the hindsight provided by the claimed invention. There is no teaching or motivation in Tadokoro and Toyooka to do what is asserted in the Office Action. There would have been no teaching or motivation for one of ordinary skill in the art to modify the sheet of Tadokoro or the laminate of Toyooka to the present invention. For example, in view of surface hardness as well as simplicity in production and cost, one of ordinary skill in the art would have had no reason to consider the laminated film resulting from the above-alleged utilization would be superior to the sheet of Tadokoro in itself. Also, in view of simplicity in production and cost, one of ordinary skill in the art would not have considered that such an alleged laminated film would be superior to the laminate of Toyooka. Thus, there would have been a strong disincentive to modify and/or combine the references in the manner proposed in the Office Action.

Moreover, as acknowledged in the Office Action (see, page 4, lines 3 of the Office Action), Tadokoro does not teach insoluble methyl methacrylate resin particles having a

weight-average particle size of 1.0 to 33 μm .¹ Although Koizumi may *arguendo* teach core-shell polymer having a weight-average particle size of 0.5 to 15 μm , Koizumi neither discloses nor would have suggested the insoluble methyl methacrylate particles having single-layer structure, such as recited in claim 1 of the present application. This means that, even if the Koizumi's particles were utilized in the composition taught in Tadokoro, it would not have been possible to arrive at the claimed invention.

In addition, Koizumi fails to teach or suggest that the insoluble methyl methacrylate particles with single-layer structure have effects on bias in thickness of the molded particle made from the resin sheet containing such particles. There is no reasonable expectation of success in Koizumi, as to such bias in thickness of the molded article. Instead, Tadokoro discloses that particles having single-layer structure are not favorable in view of the surface hardness of the resulting film (see, column 4, line 17-19 of U.S. Patent No. 6,147,162, which corresponds to WO 97/30117 to Tadokoro). Such a disclosure teaches away for using the particles having single-layer structure in a surface film,² since the surface film should have a high surface hardness according to the Examiner's statement.

Under such circumstance and without any expectation of success, Koizumi should not be modified by or combined with Tadokoro. And even if, *arguendo*, Koizumi were modified by or combined with Tadokoro, it would not have been obvious to one of ordinary skill in the art to utilize particles having single-layer structure (e.g., homogeneous composition), let alone the insoluble methyl methacrylate particles which

¹ Ex parte Brown, 19 USPQ2d (BNA) 1609, 1612 (BOPI 1990) ("since the prior art is silent as to this feature, we are unable to sustain the rejection ..."); Ex parte Isaksen 23 USPQ2d (BNA) 1001, 1006 (BOPI 2001), ("Forbes patent[s] are completely silent as to any sharpening effect and do not describe with any specificity what results to magnetic treatment had on the razor blade edge," rejection reversed).

² "A prima facie case of obviousness can be rebutted if the applicant ... can show 'that the art in any material respect taught away' from the claimed invention." In re Geisler, 116 F.3d 1465, 1469 (Fed. Cir. 1997) (quoting In re Malagri, 499 F.2d 1297, 1303 (CCPA 1974)). A reference teaches away when a person of ordinary skill, upon reading the reference, would have been led in a direction divergent from the path that was taken by Applicant.

are recited in the instantly amended claim, in a Tadokoro composition in order to have small bias in thickness of the molded article made from the resin sheet containing the particles.

As stated above, it would not have been obvious to one of ordinary skill in the art to utilize the insoluble methyl methacrylate particles recited in the instantly amended claim 1, in the Tadokoro's composition with an expectation of having the molded article with small bias in the thickness thereof.

Accordingly, there is no *prima facie* case of obviousness over the art applied in the Office Action.

Furthermore, even if there was a *prima facie* case, which there isn't, a laminated extruded resin sheet of the present invention has unexpected advantages, such as smaller bias in thickness (see, specification, page 3, lines 11-25). These advantages would have been unexpected from Tadokoro, the laminate of Toyooka, or from the combination thereof. As disclosed in Examples 1-4 in Applicant's specification, the laminated extruded resin sheets of the present invention actually have a smaller bias in thickness in comparison to the laminated sheets of Comparative Examples 1-4. Specifically, each of the laminated extruded resin sheets using resin layer (A) recited in claim 1 and 18 as an intermediate layer and resin layer (B) recited in the claims as surface layers (Examples 1-4), has a smaller bias in thickness compared to the laminated sheets which use resin layer (A) and/or resin layer (B) but are outside of the claimed invention (i.e., the two-layer laminated sheet made from resin layer (A) and resin layer (B) (in Comparative Example 1); the laminated sheet using resin layer (B) as an intermediate layer and resin layer (A) as surface layers (in Comparative Example 2); the sheet of resin layer (A) alone (in Comparative Example 3) and the sheet of resin layer (B) alone (in Comparative Example 4), each having the same thickness as the total thickness of the three-layer resin sheet obtained in Example 4).

Appl. No. 09/161,283
Amdt. dated November 4, 2003
Reply to Office Action of August 7, 2003

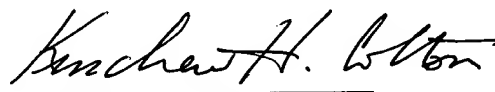
Such unexpected advantages would not have been foretold by Toyooka alone or, *arugendo*, in view of Tadokoro et al., or even *arguendo* in view of Koziiumi et al. or Toritani et al. Therefore, the claimed invention would not have been obvious to a person of only ordinary skill in the art at the time Applicant made the invention.

Appl. No. 09/161,283
Amdt. dated November 4, 2003
Reply to Office Action of August 7, 2003

Accordingly, Applicant respectfully submits there is no prima facie case of obviousness, and even if there were, which is not conceded, it has been rebutted, whereby Applicant earnestly but respectfully solicits a Notice of Allowance.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By: 
Kendrew H. Colton
Registration No. 30,368

Fitch, Even, Tabin & Flannery
1801 K Street, N.W.
Suite 401L
Washington, D.C. 20006-1201
Telephone No. (202) 419-7000
Facsimile No. (202) 419-7007



KHC/cmg
Date: May 12, 2003
Atty Docket: 7372/70988

Applicant(s): MAEKAWA
Appl. No.: 09/161,283
Filed: September 28, 1998
For: LAMINATED EXTRUDED RESIN SHEET

Paper(s) filed:

- 1) Information Disclosure Statement
- 2) PTO/SB/O8A citing 1 one reference w/copy



PLEASE DATE STAMP AND RETURN VIA COURIER